IN THE

Supreme Court of the United States

October Term, 1941

No. .....

RADTKE PATENTS CORPORATION and ALBERT A. RADTKE,
Petitioners,

against

CONWAY P. COE, Commissioner of Patents,
AMERICAN TRI-ERGON CORPORATION,
TRI-ERGON HOLDING A. G.,
WHITSON PHOTOPHONE CORPORATION and
DELMAR A. WHITSON,
Respondents.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

The Opinions of the Courts Below

The opinion of the District Court is reported at 30 Fed. Supp. 83. The opinion of the United States Court of Appeals is set forth in the record, III R. 2056.

Jurisdiction

The grounds of jurisdiction are:

1. The date of the judgment to be reviewed is June 30, 1941 (III R. 2081), rehearing denied August 29, 1941 (III R. 2094).

2. The statute under which jurisdiction is invoked is Section 240 (a) of the Judicial Code (28 U. S. C. A. 347).

Statement of the Case

The facts are sufficiently stated in the petition.

Specification of Errors

The errors which petitioners will urge, if the writ of certiorari is allowed, are that the United States Court of Appeals for the District of Columbia erred:

1. In considering and relying upon as established fact highly debatable scientific references on the question of patentability, which were neither in the record nor referred to in the briefs and which none of the parties had opportunity either to discuss or to meet with expert testimony.

2. In ignoring the question of the correctness of the decisions of the Patent Office tribunals and the incorrectness of the decision of the trial Court on the issue of priority of invention and the ancillary issues of disclosure and reduction to practice.

Argument

POINT I

Petitioners were not afforded opportunity to be heard in respect of the scientific references not in the record.

The record shows that the majority of the Court of Appeals relied upon highly debatable and questionable scientific references on the question of patentability which were neither in the record nor referred to in the briefs. It is apparent that the majority took judicial notice of these questionable references. It relied upon references some of which were published as late as the 1930's and upon statements made therein as anticipatory. It ignored the date of invention which had been accorded by the Patent Office tribunals to the petitioners. Based upon its own examination of these references, it reached the conclusion that the subject matter of the counts in suit was unpatentable.

The petitioners have had no opportunity to refute the conclusory statements made in these highly scientific references in any tribunal. They were presented to the petitioners for the first time through the means of the majority opinion of the Court below. If these conclusions and so-called findings had been presented earlier, your petitioners would have been put on notice and would have presented expert testimony as to each and every point raised thereby. That opportunity has been denied them. We submit that your petitioners have thus been denied their day in Court and their right to be heard thereon. The dissenting opinion in the Court below properly states:

> "an appellate court cannot properly reach an answer to such a question upon the basis of its own examination of data not in the record, and which may be dis-

putable, without first affording opportunity to the parties to be heard in respect of it and an opportunity to supply additional relevant data" (III R. 2080).

It is well settled that invention is a question of fact, and where a question arises whether the differences between the subject claimed in a patent in suit and the prior art amount to invention, it is necessary to introduce expert testimony as to that point. (*Walker on Patents,* Deller's Edition, Vol. 3, p. 2025.)

In

Sundh Elec. Co. v. *General Elec. Co.* (2nd Circuit), 204 Fed. 277, 279,

the Court held that highly technical matters, such as are here involved,

"* * * are matters in which a court must perforce depend upon the assertions of someone who has made a profound study of the matter".

See:

U. S. v. *Abilene & So. Ry. Co.,* 265 U. S. 274, 288.

In

Helis v. *Ward,* 308 U. S. 365, 370, 84 Law Ed. 327, 329,

certiorari was sought and granted on the ground that the Court of Appeals "had decided the merits on facts not contained in the record * * *."

POINT II

The decisions of the Patent Office tribunals awarding priority to Radtke should have been affirmed.

Upon the pleadings the only issue before the trial Court was that of priority of invention as among the three parties. In addition, it had before it the ancillary issues of disclosure and reduction to practice. The Court below wholly ignored these issues. It merely contented itself with the statement:

> "We may assume, hypothetically, that either the Patent Office or the District Court correctly decided the question of priority, as between such disclosures as may have been made by each of the parties" (III R. 2077, 2078).

The Patent Office is an administrative body of law experienced in dealing with applications for photoelectric patents, to whose well informed judgment and recognized discretion Congress has committed the determination of questions of fact on the basis of which the grant of Letters Patent is authorized. Its determination should be conclusive unless arbitrary, capricious or unsupported by substantial evidence.

The record discloses that in three separate and exhaustive decisions the Patent Office tribunals awarded priority of invention to Radtke upon that issue and the said ancillary issues. This award was based upon the fact of patentable invention.

The Court below ignored the rule firmly laid down by this Court in

Morgan v. *Daniels,* 153 U. S. 120;

wherein it stated:

> "Upon principle and authority therefor, it must be laid down as a rule that where the question decided

> in the Patent Office is one between contesting parties as to priority of invention, the decision there must be accepted as controlling upon that question of fact in any subsequent suit between the same parties, unless the contrary is established by testimony which in character and amount carries thorough conviction."

No new evidence was adduced in the trial Court and the Patent Office findings should have been accepted as conclusive.

In

Swayne & Hoyt v. *U. S.*, 100 U. S. 297, 304,

referring particularly to determinations of the Shipping Board, this Court stated:

> "Such determinations will not be set aside by courts if there is evidence to support them. Even though, upon a consideration of the evidence, a court might reach a different conclusion, it is not authorized to substitute its own for the administrative judgment." (Citing cases.)

POINT III

The questions presented here are novel and of public importance.

The questions involved are obviously important because they affect not only the present parties but also all others who may now or hereafter be in similar situations. They affect the Federal Courts and litigants therein and it is of substantial importance to the public to ascertain whether the decision of the Court of Appeals is correct.

The subject matter here involved is highly important. The fact is that the improvement involved has gone into

wide commercial use in the motion picture industry. Many licenses have been taken under the Radtke patent. It is of equal importance to the subject matter involved in *Altoona Publix Theatres Inc.* v. *American Tri-Ergon,* 294 U. S. 477.

Conclusion

The United States Court of Appeals for the District of Columbia has rendered a decision which is novel, erroneous, of public importance and seriously prejudicial to petitioners.

WHEREFORE, petitioners earnestly pray that their petition for writ of certiorari be granted and the cause be reviewed and the petitioners granted such relief as may be found just and proper.

Respectfully submitted,

LEONARD DAY,
Counsel for Petitioners.

Dated, October 6, 1941.